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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

37202/122001; 990001US

Application Number
09/892,223-Conf.
#1439Filed
June 25, 2001First Named Inventor
Scott D. CookArt Unit
3691Examiner
L. M. Hamilton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant /inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
is enclosed. (Form PTO/SB/96)☒ attorney or agent of record.

Registration number 46,479

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.



Signature

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April 15, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Scott D. Cook

Confirmation No.: 1439

Application No.: 09/892,223

Art Unit: 3691

Filed: June 25, 2001

Examiner: L. M. Hamilton

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1, 4-41, 46-49, 52-81, 84-115, 120, and 123-148 are pending in the application. In the Office Action dated January 17, 2008 (hereinafter "the Final OA"), all the claims were finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication 2003/0018549 (hereinafter "Fei"). Specifically, the Examiner is maintaining the rejections presented in the Office Action dated July 31, 2007 (hereinafter "the Non-final OA"). In maintaining these rejections, the Examiner has failed to satisfy the requirements of 37 C.F.R. § 1.104 and MPEP §§ 706, 707, and 2131 for at least the reasons given below.

37 C.F.R. § 1.104 describes the nature of examination, including requirements governing the Examiner's action. Specifically:

The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated. ... In rejecting claims for want of novelty or obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows and describes inventions other than that claimed by the applicant,

the particular part relied on must be designated as nearly as practicable. *The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.*

37 C.F.R. § 1.104 (emphasis added).

Further, MPEP § 706 states that “[t]he goal of examination is to *clearly articulate any rejection* early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” MPEP § 706 (emphasis added). Moreover, MPEP § 707.07 states:

An omnibus rejection of the claim “on the references and for the reasons of record” is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

MPEP § 707.07(d).

The aforementioned rules and guidelines clearly indicate that the Examiner bears the burden of providing a complete examination of the claims, including every dependent claim. The Examiner must examine each claim on its merits and provide a clear explanation of the reasons for any rejection. An omnibus rejection of a group of claims is improper precisely because the rejection is “not informative” and fails to provide a clear explanation for each rejection. When the reasons for a rejection are not clear, Applicant is denied the opportunity to reply completely to the rejection. Specifically, Applicant cannot “provide evidence of patentability” of a claim when the Examiner does not provide a sufficiently clear explanation of the reasons why the Examiner considers the claim unpatentable.

In the Non-Final OA, the Examiner did not provide a sufficiently clear explanation for the rejections of each of the dependent claims. The Examiner merely indicated the pages of Fei where the Examiner believes the limitations of “associated depending claims” are taught. *See* the Non-final OA, p. 4 (at the end of the first paragraph). Further, in the Final OA, the Examiner stated that she “referenced the relevant portions of the claims [and] addressed all claim limitations.” Final OA, p. 2. To the contrary, the Examiner did not reference *any* portions of the dependent claims, and did not specifically address *any* limitations of the dependent claims. The Examiner clearly grouped the dependent claims in an omnibus rejection, which is improper and denies Applicant the opportunity to reply completely to the rejections.

Moreover, even assuming *arguendo* that the Examiner’s omnibus rejection is not procedurally improper, “[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Further, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” MPEP § 2131 (emphasis added).

Fei does not describe each and every element of the claims grouped in the omnibus rejection. For example, Lei does not describe any sort of authorization other than credit card authorization. Therefore, Lei does not describe each and every element of claim 10, which recites, in part, “receiving, from a user, a request for the creditworthiness report; determining whether the user is authorized to receive the report; and responsive to the user being authorized to receive the report, outputting the report.” Further, Lei does not describe any sort of user assent to data collection. Therefore, Lei does not describe each and every element of claim 18, which recites, in part, “receiving, for each of a plurality of client machines, an indication as to whether the user of the client machine assents to data collection; and receiving transaction data


for the subject company from the client machines for which an indication of user assent was received.” Claims 10 and 18 are provided only as examples, as numerous other claims also include elements that Lei does not describe.

Returning to the requirements of 37 C.F.R. § 1.104, “[t]he pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” Clearly, the Examiner and Applicant disagree as to whether Lei describes each and every element of the claims. However, the Examiner has not clearly explained the rejections. Without knowing the specific grounds for the Examiner’s rejections, Applicant is unable to reply directly to those grounds. In other words, as noted above, Applicant cannot “provide evidence of patentability” of a claim when the Examiner does not provide a sufficiently clear explanation of the reasons why the Examiner considers the claim unpatentable. Clearly, a more thorough examination of the claims and explanation for the rejections is required.

In view of the above, the Examiner has clearly failed to satisfy the requirements of 37 C.F.R. § 1.104 and MPEP §§ 706, 707, and 2131. Accordingly, a favorable decision from the panel is respectfully requested.

Dated: April 15, 2008

Respectfully submitted,

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